



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,747	12/15/2005	Ilan Ziv	P-8440-US	1679
49443 7590 08/24/2007 PEARL COHEN ZEDEK LATZER, LLP 1500 BROADWAY 12TH FLOOR NEW YORK, NY 10036			EXAMINER VALENROD, YEVGENY	
			ART UNIT	PAPER NUMBER
			1621	
			MAIL DATE	DELIVERY MODE
			08/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/560,747

Applicant(s)

ZIV ET AL.

Examiner

Yevgeny Valenrod

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42-57 is/are pending in the application.
- 4a) Of the above claim(s) 42-46 and 55-64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 47 and 55-57 is/are rejected.
- 7) ☐ Claim(s) 48-54 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application
- ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 42, 44-45 (in part), 55-57, drawn to a method for selective targeting of a chemical compound comprising contacting the cell population with a compound of formula (I) wherein Z = non-heterocyclic and at least one A or A' is as described by group (i) or (ii).

Group II, claim(s) 42, 44-45 (in part) and 46, drawn to a method for selective targeting of a chemical compound comprising contacting the cell population with a compound of formula (I) wherein Z = non-heterocyclic and at least one A or A' is as described by group (iii).

Group III, claim(s) 42, 44-45 (in part), 59 and 63, drawn to a method for selective targeting of a chemical compound comprising contacting the cell population with a compound of formula (I) wherein Z = non-heterocyclic and at least one A or A' is as described by group (iv).

Group IV, claim(s) 42, 44-45 (in part), drawn to a method for selective targeting of a chemical compound comprising contacting the cell population with a compound of formula (I) wherein Z = heterocyclic and at least one A or A' is as described by group (i) or (ii).

Group V, claim(s) 42, 44-45 (on part), drawn to a method for selective targeting of a chemical compound comprising contacting the cell population with a compound of formula (I) wherein Z = heterocyclic and at least one A or A' is as described by group (iii).

Group VI, claim(s) 42, 44-45 (in part), drawn to a method for selective targeting of a chemical compound comprising contacting the cell population with a compound of

Art Unit: 1621

formula (I) wherein Z = heterocyclic and at least one A or A' is as described by group (iv).

Group VII, claim(s) 43 and 64, drawn to a method of detecting the presence of PNOM-cells with a cell population comprising the compound of formula (I) wherein Z = non-heterocyclic and at least one A or A' is as described by group (i) or (ii).

Group VIII, claim(s) 43 and 64, drawn to a method of detecting the presence of PNOM-cells with a cell population comprising the compound of formula (I) wherein Z = non-heterocyclic and at least one A or A' is as described by group (iii).

Group IX, claim(s) 43 and 64, drawn to a method of detecting the presence of PNOM-cells with a cell population comprising the compound of formula (I) wherein Z = non-heterocyclic and at least one A or A' is as described by group (iv).

Group X, claim(s) 43 and 64, drawn to a method of detecting the presence of PNOM-cells with a cell population comprising the compound of formula (I) wherein Z = heterocyclic and at least one A or A' is as described by group (i) or (ii).

Group XI, claim(s) 43 and 64, drawn to a method of detecting the presence of PNOM-cells with a cell population comprising the compound of formula (I) wherein Z = heterocyclic and at least one A or A' is as described by group (iii).

Group XII, claim(s) 43 and 64, drawn to a method of detecting the presence of PNOM-cells with a cell population comprising the compound of formula (I) wherein Z = heterocyclic and at least one A or A' is as described by group (iv).

Group XIII, claims 47-54 and 65-67 are drawn to compounds according to formula (V).

Group XIV, claims 58 is drawn to compound according to formula (XIV).

Group XV, claims 60-62 are drawn to compound of formula (XV) or (XVI).

The inventions listed as Groups I-XV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the technical feature linking the inventions, the compound of formula (I). Said compound fails to meet the

Art Unit: 1621

requirements for being a special technical feature. Jones et al (US 5,876,956) disclose dansyl glycine (Figure 2; column 3, line 66-67). Dansyl glycine breaks the unity of the instant claims.

Notice of Potential Rejoinder

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result**

Art Unit: 1621

in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Telephone election

During a telephone conversation with Guy Yonay on 8/7/07 a provisional election was made with traverse to prosecute the invention of Group XIII, claims 47-54 and 65-67. Affirmation of this election must be made by applicant in replying to this Office action. Claims 42-46 and 55-64 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 65 recites the limitation "compound being linked through a linker or directly to..." in lines 1-3. There is insufficient antecedent basis for this limitation in the claim.

Claim 47 does encompass in its generic definition compounds connected to metals,

Art Unit: 1621

linkers, solid support etc. The breadth of claim 65 is therefore outside of the scope of claim 47.

Claims 51 and 52 recite a structural limitation where R^3 or R^4 is a $-\text{CH}_2\text{COOH}$. There is insufficient antecedent basis for this limitation in the claim. Claim 47 does not include the above moiety in the definition of R_3 or R_4 .

Claim 47 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 47 is a compound claim that depends on a method claim (42). Examiner suggests importing the definitions of R^3 and R^4 into claim 47 rather than referring to claim 42.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 47, 66 and 67 rejected under 35 U.S.C. 102(b) as being anticipated by Jones et al (US 5,876,956).

Jones et al. disclose Dansyl glycine (Figure 2) which anticipates the compound of formula (V) when $R^3, R^4 = H$, and $T = N(Me)_2$. The dansyl group is a marker for fluorescence imaging. Jones et al. utilize the fluorescence imaging to detect cells comprising dansyl glycine (Column 4, lines 40-44).

The limitation directed to the detection of PNOM-cells in claim 66 is treated as an intended use. It is well settled that the intended use of a composition or product (e.g. as a cosmetic composition) will not further limit claims drawn to a composition or product, so long as the prior art discloses the same composition comprising the same ingredients in an effective amount as instantly claimed. See, e.g., *Ex parte Masham*, 2 USPQ2d, 1647.

Claim 65 is rejected under 35 U.S.C. 102(b) as being anticipated by Hua et al. *Biochemistry*, 1995, 34, 5137-5142). Hua et al disclose a compound of formula 1 linked directly to a therapeutic drug (see dansylthapsigargin, page 5138, Figure 1, Compound 3).

Claim objections

Claims 48-54 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion


Claims 47 and 65-67 are rejected.

Claims 48 – 54 are objected to.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yevgeny Valenrod whose telephone number is 571-272-9049. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Yevgeny Valenrod
Patent Examiner
Technology Center 1600



Yvonne Eyler
Supervisory Patent Examiner
Technology Center 1600